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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

81887.0124

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on _____

Signature _____

Typed or printed name _____

Application Number

10/538,165

Filed

June 8, 2005

First Named Inventor

Hiroyuki HIDAKA

Art Unit

2617

Examiner

Marivelisse Santiago Corde

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

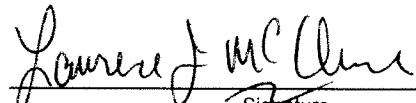
assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. Registration number 44,228

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



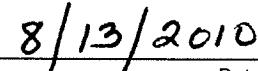
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Lawrence J. McClure

Typed or printed name

310-785-4755

Telephone number



Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Applicant respectfully submits that there have been clear factual errors made with regard to each of the outstanding rejections. Claims 3, 4, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over FIG. 3C and FIG. 4 of applicant's specification.

Contrary to the Action's assertion, (1) FIG. 3C is not prior art, and the assertion that FIG. 3C is prior art constitutes clear factual error. Moreover, even assuming the FIG. 3C is prior art, (2) FIG. 3C and FIG. 4 do not render obvious the claims of present invention. Thus, the assertion that the combination of FIG. 3C and FIG. 4 obviate the claims of present application is clear factual error.

(1) FIG. 3C Is not Prior Art

Applicant's specification sets forth, unequivocally, that FIG. 3C is not prior art. In the "Brief Description of the Drawing" section, the specification provides that a conventional system includes a "suspend time" in the operation (page 7, lines 16-17). Further, the original claim 4 provides, "...the setting section does not set the suspend time in a case...." Thus, the specification clearly regards a system having no suspend time as one aspect of its invention, and not prior art.

Additional support can be found in, for example, applicant's specification at page 3, lines 4-14 (the background section). The cited section states:

Incidentally, in the 1xEVDO system, the wireless communication terminal awaits in a measurement status where an incoming signal output from the base station can be received during a certain period of time after completion of communication processing with the base station,... For this reason, the antenna and the radio section are occupied by the 1xEVDO system for a certain period of time after termination of communication.

The cited section indicates that the prior art 1xEVDO system has a non-zero suspend time ("...the antenna and the radio section are occupied by the 1xEVDO system for a certain period of time after termination of communication").

Moreover, applicant's specification at page 17, last paragraph states,

The wireless communication terminal of the present embodiment of the invention is configured such that, in order to solve the problem, the suspend time of the 1xEVDO system is...such that the suspend time is not set when the processing for communication with the base station has ended properly.

The cited section of applicant's specification states that that the "related art" 1xEVDO system has a set (non-zero) suspend time and that only in the present invention is the suspend time not set.

In sum, the specification sets forth that a suspension time is "conventional." FIGS. 3A and 3B are the timing charts during the operation of a conventional suspend time. FIG. 3C, however, does not have a suspend time and thus, is not the timing chart for a conventional system.

Instead of examining the claims as clearly stated in the specification, the Examiner seize upon a generality within the specification and argues that FIG. 3C is prior art by admission. In particular, the Action cites specification at page 7, lines 16-17 stating, "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a **conventional suspend time**" (emphasis added), and argues that the sentence denote an admission.

Applicant submits that, on the contrary, the cited sentence unambiguously identifies FIG. 3C as **not** prior art. The term "conventional" refers to the "suspend time." FIGS. 3A and 3B illustrate the "Suspend Time." FIG. 3C, however, illustrates a timing **without the conventional suspend time**. Further, applicant's specification at page 14, lines 11-12 states, "Fig. 3C is a timing chart of a case where a suspend time is not set (**specifically, Suspend Time = 0**)." (Emphasis added).

Even if the cited sentence is ambiguous regarding FIG. 3C, the remainder of applicant's specification sets forth, as discussed above, that FIG. 3C is not prior art.

Moreover, the description at page 7, lines 16-17 does not meet the standard of admission **because the description does not posit that FIG. 3C is the "work of another."** MPEP 2129.I provides that applicant's statement would constitute prior art by admission only if the statement identifies the "work of another." Even if the work is labeled as "prior art," the work is still not be prior art if it is not the "work of another." (MPEP 2129.I citing Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988)).

Here, specification does not state or suggest that FIG. 3C is the "work of another." As discussed above, the description at page 7, lines 16-17 clearly states that a suspension

time is “conventional.” FIG. 3C itself and the specification at page 14, lines 11-12 provide that FIG. 3C is a timing chart without the conventional suspension time. Further, the Examiner could not specify where the specification labeled FIG. 3C as the “work of another.”

And, on the contrary, it clear from the specification that a communication terminal having no suspend time is the work of the inventor of instant invention. See, for example, claim 2 as originally filed stating, “[A wireless communication terminal..., comprising: a setting section,] wherein the setting section does not set the suspend time....” As shown above, the inventor of instant invention claims a communication terminal having no suspend time as his own invention.

Since FIG. 3C is not the “work of another,” FIG. 3C cannot be prior art by admission.

Further, the Action attacks application’s position that the if FIG. 3C was prior art, then persons of ordinary skill in the art would understood that having no conventional suspend time would deteriorate data communication and thus was to be avoided. The Action at page 4, first 4 lines argues that, “Thus statement raises the following question: if not setting the suspend time was not prior art, as Applicant intent to argue, then how comes not setting the suspend time as under stood by those in the art to deteriorate data communication?”

Applicant’s position regarding the persons of ordinary skill in the art was within the ambit of a hypothetical case that FIG. 3C was indeed prior art. Applicant’s response of March 2, 2010 at page 9 states, “Even assuming *arguendo* that FIG. 3 of applicant’s specification constitutes prior art (AAPR), the cited art still does not render the claims obvious.” (Emphasis original). The position cited by the Action is detailed in pages 9-11 of the response after the statement above and thus, is part of the hypothetical case.

Since applicant’s position regarding the knowledge of the negative effects of FIG. 3C was for the hypothetical case that FIG. 3C was prior art, applicant did not acknowledge that the system of FIG. 3C was known in the art.

(2) FIG. 3C Teaches Away from Proposed Modification

The Action argued the FIG. 3C is prior art, and found that the combination of FIG. 3C and FIG. 4 obviate claim 1. Applicant disagrees. Even assuming *arguendo* that FIG. 3

of applicant's specification constitutes prior art (AAPR), the cited art still does not render the claims obvious. The Action argues that FIG. 3C teaches a 1xEVDO device that does not set a suspend time, which would result in reduced power consumption. Citing the power reduction as the motivation, the Action further argues that the combination of FIG. 3C and FIG. 4 obviated claim 3 of present application.

Applicant respectfully asserts that the claimed invention is not obvious in view of United States v. Adams, 86 S. Ct. 708, 713 (1966) and KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727 (2007). In Adams and KSR, Supreme Court noted that strong indicia of non-obviousness included: (1) the prior art teaches away from the claimed combination of elements and (2) the claimed combination of elements delivers unexpected results.

The Adams case is particularly illustrative. The patent at issue in Adams was directed at a wet battery having a magnesium anode and water electrolyte. At that time, batteries with zinc anodes were known, and the Government relied on the Wood reference and the Codd reference for its invalidity argument. Wood taught that a magnesium electrode would produce a high voltage cell, which was desirable. However, Wood also taught that magnesium was unsuitable for battery because magnesium was susceptible to corrosion (Adams at 711, 712). Codd likewise suggested that magnesium was a good candidate for anode, but also noted that a battery containing an acid would destroy the magnesium anode (Adams at 712).

The Court held that, **although the advantages of using a magnesium anode were known, the combination of elements including magnesium was not obvious.** The Court took notice that (1) the known disadvantages of using the magnesium anode would dissuade its usage (Adams at 714, citing that water electrolyte used by Adams was "detrimental to the use of magnesium"), and (2) the claimed device "wholly unexpectedly" produced "certain valuable operating advantages over other batteries" (id.)

As with Adams, the claims of present application are patentable over the cited art. The Action argued that the FIG. 3C provided that the 1xEVDO entering a sleep mode with no set suspend time would save power. Ostensibly, the power-saving measure would be the motivation to combine the features FIG. 3C with the device of FIG. 4.

The Adams and KSR decision mandate the conclusion that the claim 1 is not obviated by FIG. 3C and FIG. 4. As in Adams, the “prior art” of instant case **teaches away** from the proposed combination. Applicant’s specification at page 14, line 24 states, in reference to FIG. 3C, “Specifically, when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good.” Applicant’s specification thus makes clear that not setting the suspend time was understood by those in the art to deteriorate data communication and thus was to be avoided. Since the **primary purpose of a communication device is to enable communication**, practitioners would not have been motivated to not set a suspend time. And the Office’s stated motivation “conserving battery power” would not have motivated the artisans in the art as in Adams.

Furthermore, as in Adams, the claimed invention produces unexpected and fruitful results contrary to the prior art’s teaching. The inventors of the present invention discovered (among other things) that, in certain operations, not setting the suspend time would not impact the communication perform. This insight is not seen based on the disclosure of FIG. 3C. In particular, claim 3 recites a condition that the device switches to 1xEVDO when “the second changing section changes the monitoring timing of the first communication protocol by communicating with the base station.” In that condition, the device may have a suspend time of zero (not setting the suspend time), and the communication performance would not deteriorate. In parallel, Adams’ battery was stable, contrary to the prior art’s assertion. As with the instant case, Adams discovered a product with unexpected and fruitful results via insights not seen in the prior art.

The Action attacks the importance of the deteriorating communication arising from the zero suspend time, and argues that the deterioration only occurs in poor radio wave condition. However, as the recent storm over the communication performance of iPhone 4 shows, even minor deterioration in communication performance is of grave concern to the users and artisans in the art.

In view of forgoing, applicant submits that FIG. 3C is not prior art, and/or claim 3 is not obviated by FIG. 3C and FIG. 4 of applicant’s specification. Thus, the § 103(a) rejections of claim 3 should be withdrawn.